

Appl. No. : 09/991,445
Filed : November 16, 2001

fluorocarbon or modifier gas was made at any time during examination: U.S. Patent Nos. 5,639,443; 6,372,195; 6,258,339; 5,605,673; 5,720,938; 5,626,833; 6,287,539; 5,695,741; 6,280,704; 6,280,705; and 5,798,091 are just a few examples. Examples of patents with similar claim scope owned by other entities can also be provided. Thus applicants do not believe that the present application would be at all burdensome to search and examine. Regardless of whether a patent application claims inventions that are "independent" or "distinct", a restriction requirement should not be made if a search and examination of the entire patent can be made without serious burden. MPEP 803.02. Clearly, that is the case here as is shown by the scope of the claims of the above mentioned issued patents.

It is also respectfully pointed out that the Examiner cited no reasons for the restriction requirement as required under MPEP 803.01 (see "Guidelines") other than that "claims 1 - 20 are generic to a plurality of distinct species comprising a fluorocarbon and a modifier gas." However, it would not be true that "claims 1 - 20 are generic". For example, what are Markush claims 9, 14 and 20 generic to? What would claim 11 be generic to?

There has also been no showing by the Examiner that the inventions are separately classified, have a separate status in the art or would be found in a different field of search. Further, the species of gases listed are related in that there is unity of invention among the various listed gases (see MPEP 803.02 and In re Haas, 580 F.2d 461, 198 USPQ 334 [CCPA 1978]). Unity is shown when compounds included within a Markush group: (1) share a common utility; and, (2) share a substantial structural feature disclosed as being essential to that utility. The fluorocarbon compounds listed throughout claims 1 - 20 all have a common utility in that they may be used in *in vivo* microbubble applications for oxygen delivery because they are inert and have very low water solubilities.

The Examiner has requested that should the applicants traverse the requirement, that applicants go on record and admit that all of the various fluorocarbon species are obvious variants as used within the claims. However, this procedural step is not a requirement under the MPEP and nor would it be true that all fluorocarbon species are obvious variants of one another as used within the context of the claims. The applicants have a right to have their patent

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application examined without the scope of the claims being unduly restricted forcing the filing of multiple divisional applications.

Applicants hereby respectfully request withdrawal of the requirement for election of species. Applicants also have requested a three month extension of time. If there are any questions, applicants' attorney can be reached at the telephone number stated below.

Respectfully submitted,

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By: John Wurst
John Wurst
Registration No. 40,283
Attorney of Record
(858) 410 - 5174